



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/929,398

08/14/2001

Donald S. Krynski

019333-000210US

9152

20350

7590

08/26/2005

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

GRAYSAY, TAMARA L

ART UNIT

PAPER NUMBER

3623

DATE MAILED: 08/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/929,398

Applicant(s)

KRYNSKI ET AL.

Examiner

Tamara L. Graysay

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>(2 pages)</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Drawings

1. The drawings are objected to because of the following:
 - a. Figure 4, the unlabeled arrow to the left of decision diamond 402 is confusing insofar as the specification indicates that step 402 is the start, yet the unlabeled arrow infers input from another source.
 - b. They fail to comply with 37 CFR .184(h)(2) because a smaller scale view should be included showing the whole formed by the partial views and indicating the position of the parts shown. In the present application, Figures 4 and 5A-5E and 6 appear to be partial views; however, there is no smaller scale view showing the whole.
 - c. They fail to comply with 37 CFR .184(h)(2)(i) because the views on the several sheets must be so arranged that the complete figure can be assembled without concealing any part of any of the views appearing on the various sheets. In the present application, the partial views illustrated in Figures 4 and 5A-5E and 6 cannot be assembled without concealing any part of the other partial views.
 - d. They fail to comply with 37 CFR 1.84(u)(1) because Figures 4 and 5A-5E and 6 appear to be partial views intended to form one complete view; however, they are not identified by the same number.
 - e. The figures do not illustrate that which is described at page 13, lines 2-3, i.e., the billing notification is issued in step 588 and processing loops back to step 534. The loop back to step 534 is not illustrated, but rather the process ends at step 588 as illustrated in Figure 5D.

Art Unit: 3623

- f. They fail to comply with 37 CFR 1.84(p)(4) because reference character “524” has been used to designate both “register data capture device to customer and contract” (Fig.5A-5E) and “determine technician for customer” (Fig.6).
- g. They fail to comply with 37 CFR 1.84(p)(4) because reference character “528” has been used to designate both “ship data capture device to customer” (Fig.5A-5E) and “service message sent to appropriate technician” (Fig.6).
- h. They fail to comply with 37 CFR 1.84(p)(4) because reference character “532” has been used to designate both “user installs data capture device” (Fig.5A-5E) and “technician interacts directly with customer if necessary” (Fig.6).
- i. They fail to comply with 37 CFR 1.84(p)(4) because reference character “536” has been used to designate both “operations center programs data capture device” (Fig.5A-5E) and “technician performs repairs if necessary” (Fig.6).
- j. They fail to comply with 37 CFR 1.84(p)(4) because reference character “540” has been used to designate both “any service condition detected?” (Fig.5A-5E) and “status of service call updated in database” (Fig.6).
- k. The reference character used to depict the “technician interacts directly with customer if necessary” must be included in the specification (see page 14, lines 16-23).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet”

Art Unit: 3623

pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The disclosure is objected to because of the following informalities:
 - a. The use of acronyms is acceptable, however, each should be spelled out at least at its first occurrence (WAP at page 3, line 15).
 - b. The use of the trademark(s) WAP and MOTOROLA and SKYTEL has been noted in this application. Each should be capitalized wherever it appears and be accompanied by the generic terminology. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.
 - c. Page 4, line 15, "data center 112" should be data center 122, see figure 1A.
 - d. Page 4, line 29, "data processor" should be data processor 204, see figure 2.
 - e. Page 6, line 32, "customer database 323" should be customer database 332, see figure 3.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 17, 22, and 27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to nonstatutory subject matter.

Claim 17 is a system claim that includes in its scope a plurality of service technicians. The service technicians are disclosed to be human beings. Human beings are nonstatutory subject matter. Therefore, the claims include a human being in their scope, and are deemed nonstatutory subject matter.

Claim 22 is a method for automating management of a service contract, however, the scope of the claim is not within the technological arts. The broadest reasonable interpretation of the claim is an abstract idea. For example, providing a data capture device proximate a business machine (a writing surface, a piece of paper, etc.); generating a service call automatically from at least one of user input and the data capture device (a user speaking the word “help”); receiving the service call by a technician (someone hears the user’s word); wirelessly notifying the technician of the service call for the business machine (someone tells the technician to go on a service call); and contacting the user by the technician based upon the wirelessly notifying step (the technician performs the service call). Such an abstract idea is not within the technological arts insofar as the claim does not include any technology, but rather can be performed using paper, pencil, and human interaction alone.

Further regarding claim 22, the steps of receiving and wirelessly notifying appear to be directed to the same step. The step of receiving by the technician followed by notifying the technician is confusing because the step of wirelessly notifying the technician of the service call is claimed as being performed independently of the technician receiving the service call.

Whereas Figure 6 for example depicts sending a message to the technician as a single step

Art Unit: 3623

(currently labeled as 528), not two separate steps. The steps should be related to each other or clearly distinguished from each other in order to clarify the scope of the claim and the metes and bounds of patent protection desired.

Further regarding dependent claim 27, the recitation of the particulars of technology (the type of business machine) does not overcome the lack of technological arts because the process does not manipulate the business machine. Rather, the data capture device is “proximate” to the business machine but not functionally or structurally related thereto, i.e., the business machine is not affected by the method.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-13, 15-16, and 20-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the step of “receiving” is confusing and indefinite insofar as there is not sufficient structure associated with the step to enable the step to be performed. The claim is unclear as to how or where the receiving occurs, the receiving step is not related to the data capture device or the business machine.

Regarding claim 15, the associated business machine is confusing because there is a plurality of business machines recited in antecedent. The claim must be clarified as to which associated business machine is being claimed since there is a plurality of data capture devices

Art Unit: 3623

recited in antecedent and each device is coupled to an associated business machine. See contrasting language used at claims 17-19.

Regarding claim 20, the data capture device is confusing because there is a plurality of data capture devices recited in antecedent.

Regarding claim 21, the wireless transceiver is confusing because a plurality of data capture devices is recited in antecedent and each data capture device comprises a wireless transceiver. Therefore, there is a plurality of wireless transceivers. The recitation of “the wireless transceiver” is confusing because there is more than one transceiver recited in antecedent.

Regarding claim 22, the step of “receiving” is confusing and indefinite insofar as there is not sufficient structure associated with the step to enable the step to be performed. The claim is unclear as to how or where the receiving occurs, and the receiving step is not related to the data capture device or the business machine.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-13 and 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caruso (article, Children’s hospital shines light on net problems).

Art Unit: 3623

a. Regarding claim 1, Caruso discloses a method including the steps of providing a data capture device (NerveCenter) proximate (building 1 and building 2, for example) to a business machine (uninterruptible power supply or UPS)[software collects information, 27:B:4]; determining a threshold event (utilization is high, batter is low, power failure)[27:B:5,6]; programming the threshold event into the data capture device [27:B:5,6]; receiving notification (manager notified by pager) of triggering of the threshold event [27:B:6]; reporting information related to the contract electronically and automatically to the user (the company) based at least in part on the receiving step (lists users and devices, highlights events)[27:B:6].

Caruso does not mention the type of agreement used in maintaining the system. However, the term service contract has been interpreted broadly to mean any service(s), process(es), or act(s), whether in-house or outsourced by a person performing the method. A contract is an abstract idea, and as such, has not been claimed *per se*, but rather the process of implementing a service is claimed. Even if a service contract were required the outsourcing of services that are neither familiar to a company nor within its expertise is well known in the business field in order for a company to remain focused on its organizational goals.

b. Regarding claim 2, Caruso discloses receiving a service call by a technician (manager) automatically generated from user (company) input [27:B:6, the manager is notified of a problem automatically]. The user input in the Caruso reference is a signal from the UPS.

c. Regarding claim 3, Caruso discloses the use of pagers, which are wireless devices, to notify the technician [27:B:6].

d. Regarding claim 4, the examiner takes Official notice that it is well known in business that business contact each other, and more specifically that a service provider would contact an entity receiving services. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Caruso to include the step of contacting the company by a technician, in order for the technician to perform the needed services.

e. Regarding claim 5, the examiner takes Official notice that web interfaces are a common way for users to interface with a computer system. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Caruso to include a web interface on the network to enable a user to input information and to graphically receive information via the computer network.

f. Regarding claim 6, the use of automatic contract renewals is common in business to prevent lapse of critical or important agreements among parties. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Caruso to include provision for automation of renewals in order to prevent lapse of critical or important agreements among parties.

g. Regarding claim 7, the claimed “point remote to” is a relative term that was met by Caruso which depicts a keyboard separate from the NerveCenter hard drive.

h. Regarding claim 8, the determining step is performed remote to the data capture device insofar as the UPS sends information that is used to determine whether a critical event happened [27:B:6].

i. Regarding claim 9, Caruso discloses an embodiment in which a user may call the help desk for assistance or to report a critical event. Although Caruso improves upon the method of manual activation, by placing a call to the help desk, the disclosure of Caruso as a whole teaches a combination of manual and automatic requests for service when a critical event occurs. Further, the structural modification of the data capture device is not manipulated by the method and as such is not given patentable weight in the method or process claims.

j. Regarding claim 10, Caruso includes a wireless transceiver that is used to page the manager when a critical event happens [27:B:6]. Further, the structural modification of the data capture device is not manipulated by the method and as such is not given patentable weight in the method or process claims.

Art Unit: 3623

k. Regarding claim 11, the term contract has been interpreted broadly to mean any service(s), process(es), or act(s), whether in-house or outsourced by a person performing the method. Caruso discloses a percentage of contract, for example, 85% utilization of the link [27:B:6].

l. Regarding claim 12, Caruso discloses a method that includes lists. In order to determine the items included on the list, the data capture device inherently performs the step of querying for information.

m. Regarding claim 13, Caruso includes the steps of remotely monitoring usage of supplies (determining when batteries are low, for example)[27:B:5], and notifying the user when ordering supplies is predicted to be warranted (the manager is notified when the batteries are low)[27:B:6].

n. Regarding claim 22, Caruso discloses a method including the steps of providing a data capture device (NerveCenter) proximate (building 1 and building 2, for example) to a business machine (uninterruptible power supply or UPS)[software collects information, 27:B:4]; generating a service call automatically from the data capture device (the manager is notified of a critical event via a pager system)[27:B:6]; receiving a service call by a technician (manager) automatically generated from user (company) input [27:B:6, the manager is notified of a problem automatically and the user input in the Caruso reference is a signal from the UPS]; wirelessly notifying the technician of the

Art Unit: 3623

service call for the business machine (pagers, which are wireless devices, are used to notify the technician)[27:B:6].

Caruso lacks the step of contacting the user based upon the wirelessly notifying step. However, the examiner takes Official notice that it is well known in business that business contact each other, and more specifically that a service provider would contact an entity receiving services. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Caruso to include the step of contacting the company by a technician, in order for the technician to perform the needed services.

Caruso does not mention the type of agreement used in maintaining the system. However, the term service contract has been interpreted broadly to mean any service(s), process(es), or act(s), whether in-house or outsourced by a person performing the method. A contract is an abstract idea, and as such, has not been claimed *per se*, but rather the process of implementing a service is claimed. Even if a service contract were required the outsourcing of services that are neither familiar to a company nor within its expertise is well known in the business field in order for a company to remain focused on its organizational goals.

o. Regarding claim 23, Caruso discloses determining a threshold event (utilization is high, batter is low, power failure)[27:B:5,6]; programming the threshold event into the data capture device [27:B:5,6]; receiving notification (manager notified by pager) of triggering of the threshold event [27:B:6]; and reporting information related to the

Art Unit: 3623

contract electronically and automatically to the user (the company) based at least in part on the receiving step (lists users and devices, highlights events)[27:B:6].

p. Regarding claim 24, Caruso discloses a malfunction as the threshold event (power failure [27:B:6], low battery [27:A:4], bad network card [27:C:7], link utilization [27:B:2,6]).

q. Regarding claim 25, Caruso discloses an embodiment in which a user may call the help desk for assistance or to report a critical event. Although Caruso improves upon the method of manual activation, by placing a call to the help desk, the disclosure of Caruso as a whole teaches a combination of manual and automatic requests for service when a critical event occurs. Further, the structural modification of the data capture device is not manipulated by the method and as such is not given patentable weight in the method or process claims.

r. Regarding claim 26, the examiner takes Official notice that web interfaces are a common way for users to interface with a computer system. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Caruso to include a web interface on the network to enable a user to input information and to graphically receive information via the computer network.

Art Unit: 3623

- s. Regarding claim 27, the business machine in Caruso is a multifunction device, as broadly recited, insofar as the UPS device both guards against power failure and provides back up power if there is a power failure.
6. Claims 14-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fraker (US-5919239).
- a. Regarding claim 14, Fraker discloses a plurality of data capture devices (e.g., logging system 10, including memory 22); each data capture device coupled to a business machine (e.g., 106); and each data capture device comprises a wireless transceiver (e.g., 76); an operations center (e.g., 14, 90) in two-way communication (e.g., 76 to 82) with each data capture device, wherein the operations center determines a threshold and communicates that threshold to one of the data capture devices (e.g., abstract, the apparatus may include a radio transceiver for exchanging data and/or programming information); and a web interface to the operations center (e.g., represented by screen 94).

Fraker lacks a threshold related to a service contract. However, Fraker does include a monitoring the business machine (e.g., vehicle engine temperature) and determines its relationship to a threshold (e.g., 9:37-10:2). The examiner takes Official notice that vehicles are serviced whether routinely or preventatively and that service for fleet vehicles is commonly performed under a service contract in order to ensure that the vehicles are maintained to avoid unexpected unavailability.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fraker to include a threshold defined by a service contract in order to determine when a vehicle is in need of service.

b. Regarding claim 15, a vehicle is inherently a multifunction device, as broadly recited.

c. Regarding claim 17, Fraker does not assign a technician (driver) to each business machine (vehicle), however, each vehicle would inherently have a driver or operator assigned to it.

d. Regarding claim 18, Fraker discloses the data capture device as part of the business machine (vehicle), but stops short of the data capture device being integral thereto. The term "integral" is sufficiently broad to embrace constructions united by such means as fastening and welding (in re Hotte (C.C.P.A.) 157 U.S.P.Q. 326); the term is not necessarily restricted to a one-piece article (in re Kohno (C.C.P.A.) 157 U.S.P.Q. 275); and may be construed as relatively broad (in re Dike (C.C.P.A.) 157 U.S.P.Q. 581).

e. Regarding claim 19, Fraker depicts one service terminal; however, the number of service terminals is a matter of design choice that is within the level of ordinary skill in the business field and would, for example, be dependent upon the regional or quantitative parameters of the business machines (vehicles).

f. Regarding claim 20, the data capture device comprises a mechanism for sending a signal to the operations center. The statement of intended use for the mechanism is not given patentable weight insofar as the mechanism is not in means plus function language.

7. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fraker (US-5919239) in view of Mazzapica (cited by applicant, US-5930342).

Fraker is for managing vehicles, i.e., outdoor business machines, rather than generally indoor office machines. Mazzapica teaches management of business machines including copiers and fax machines including maintenance and unauthorized movement or use. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fraker to include a fax or copier, i.e., business machines that are generally used indoor rather than outdoor, such as suggested by Mazzapica, in order to monitor location and maintain operability of the indoor machines.

8. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fraker (US-5919239) in view of Gralla (book, How the internet works).

Fraker discloses the transceiver and operations center coupled via a public access medium. A wide area network is a type of public access medium, as evidenced by the wide area network in Gralla. A wide area network is a public access medium that connects electronic devices among many sites. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fraker to include a wide area network public access

Art Unit: 3623

medium, such as suggested by Gralla, in order to connect devices that are remotely located at different sites.


Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamara L. Graysay whose telephone number is (571) 272-6728. The examiner can normally be reached on Mon - Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 8/18/05
Tamara L. Graysay
Examiner
Art Unit 3623

20050812